

Application No. 10/606,786
Response to Office Action dated March 3, 2008

REMARKS

Claims 47 and 48, directed to specific liquid fatty alcohols, have been added. Support for these new claims exists, *inter alia*, at page 7 of the present application.

Claims 1-48 are currently pending, although claims 44-46 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants respectfully request rejoinder of claims 44-46, which depend from claim 1, pursuant to MPEP § 821.04.

The Office Action rejected claims 1-8, 10 and 11 under 35 U.S.C. § 102 as anticipated by U.S. patent 6,231,877 (“Vacher”), claims 1-7, 10-14, 17-20, 28-31 and 34-43 under 35 U.S.C. § 102 as anticipated by U.S. patent 5,556,615 (“Janchitraponvej”), and claims 1-43 35 U.S.C. § 103 as obvious over Janchitraponvej in view of U.S. patent 4,390,522 (“Jacquet”), U.S. patent 6,214,326 (“Dupuis”), U.S. patent 6,224,888 (“Vatter”), and J. Am. Oil Chemists Soc. (“Monick”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to transparent compositions containing at least one silicone with quaternary ammonium groups and at least one liquid fatty alcohol. As explained in the Background section of the present application, this unique combination of elements provides, among other things, transparent compositions with good hair conditioning properties despite the fact that such compositions contain liquid fatty alcohol. Such unique compositions are neither taught nor suggested by the applied art. That is, the art upon which the Office Action has relied neither teaches nor suggests the claimed invention, nor would such art lead one skilled in the art to the claimed invention with a reasonable expectation of success of producing a transparent composition.

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Regarding the rejections under 35 U.S.C. § 102, the Office Action has based these rejection on the assumption that the cetyl alcohol in Vacher and the oleth-20 in Janchitraponvej satisfy the liquid fatty alcohol requirement in the pending claims. However, this is not the case. As demonstrated by the attached supplier information, oleth-20 is solid (Tabs A and B) and has a melting point (Tab C), and cetyl alcohol has a melting point (Tab D). Also, the text from Encyclopedia Britannica website demonstrates that cetyl alcohol is solid:

cetyl alcohol *also called 1-hexadecanol* [CH₃(CH₂)₁₅OH], a solid organic compound that was one of the first alcohols to be isolated from fats. Cetyl alcohol was discovered in 1817 by the French chemist Michel Chevreul. When he heated a sample of spermaceti (a solid wax formed by the cooling of sperm whale oil) with caustic potash (potassium hydroxide), colourless crystals appeared. Although Chevreul thought that these...
cetyl alcohol... (75 of 206 words)

Thus, neither of the alcohols upon which the Office Action has relied is a liquid alcohol. For at least this reason, neither Vacher nor Janchitraponvej discloses all of the elements required by the pending claims, and Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102.

Furthermore, with respect to new claims 47 and 48, cetyl alcohol and oleth-20 are not covered by these new claims for the additional reason that cetyl alcohol is a linear, saturated C16 compound and oleth-20 has 20 alkylene oxide groups.

Regarding the rejection under 35 U.S.C. § 103, Janchitraponvej does not teach or suggest adding a liquid fatty alcohol to his compositions. This is a significant omission, particularly in view of the fact that Janchitraponvej was seeking to produce “clear” compositions. (See, for example, col. 1, line 12). As explained at page 2, lines 4-6 of the present specification, conventional compositions containing liquid fatty alcohols were not

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transparent. Thus, the fact that Janchitraponvej was seeking to produce “clear” compositions explains why Janchitraponvej did not include liquid fatty alcohols as possible ingredients for inclusion into his compositions: adding liquid fatty alcohols to his compositions would have resulted in non-transparent compositions and, thus, would have been contrary to his purposes. Under such circumstances, no motivation could have existed to add liquid fatty alcohol to Janchitraponvej’s compositions. See MPEP § 2143.01. In other words, no motivation would have existed to add a liquid fatty alcohol to Janchitraponvej’s compositions with the expectation that a transparent composition would result based upon the teachings of the applied art.

Jacquet cannot compensate for Janchitraponvej’s deficiencies. That is, Jacquet would not motivate one skilled in the art to add liquid fatty alcohols to Janchitraponvej’s “clear” compositions. Jacquet’s disclosure of alcohols relates to producing “creams.” (See, col. 6, line 67 et seq.). Because “creams” are recognized by those skilled in the art as being opaque, not clear, Jacquet teaches adding alcohols to produce opaque compositions, not clear compositions. Thus, no motivation would have existed to add Jacquet’s alcohols (used to produce non-clear creams) to Janchitraponvej’s clear compositions. Again, such an addition would have been contrary to Janchitraponvej’s purposes.

Dupuis, Vatter, and Monick also fail to compensate for Janchitraponvej’s fatal deficiencies. Dupuis and Vatter are cited merely for their disclosure of specific compounds. Monick is cited merely for its generic, non-informative disclosure relating to physical properties of alcohols. None of these references would lead one skilled in the art to prepare a transparent composition containing, among other ingredients, a liquid fatty alcohol with the expectation that a transparent composition would actually result. The pending § 103 rejection

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constitutes nothing more than impermissible hindsight, using the present application as a guide, to combine the required elements together in such a way to yield the claimed transparent compositions. In other words, without Applicants' invention, the rejection could not be supported. Such a rejection is improper and should be withdrawn.

Applicants respectfully submit that for at least this reason no *prima facie* case of obviousness has been set forth.

Furthermore, even assuming a *prima facie* case of obviousness has been set forth -- which is not the case -- sufficient evidence of unexpected/surprising results exists to rebut any such hypothetical case of obviousness. More specifically, the previously submitted Rule 132 declaration demonstrates the unexpected/surprising results associated with the claimed compositions.

The Office has previously questioned the statistical significance of the data in the Rule 132 declaration, and asserted that the difference set forth in the declaration between the properties of the invention composition and the comparative compositions was merely one of degree, not kind. However, this assertion ignores the evidence of record set forth in the declaration. Specifically, the declaration indicates that the demonstrated differences are significant, and demonstrate that the invention compositions have unexpectedly and significantly better flexibility, smoothness and turbidity properties than comparative compositions according to standard testing methods. That is, the invention compositions were determined to be significantly better than comparative compositions using standard testing. Such evidence, by itself, is sufficient to demonstrate the unexpected benefits associated with the claimed compositions.

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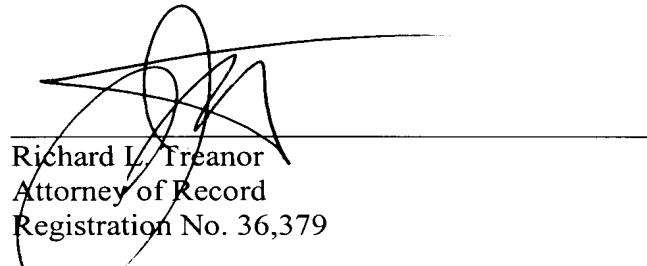
The unique combination of elements required by the present invention results in compositions having improved sensory and transparency characteristics. Compositions which do not contain either the required silicone with quaternary ammonium groups or the required liquid fatty alcohol do not possess such improved transparency and sensory characteristics. Clearly, the improved compositions of the present invention are neither taught nor suggested by the cited art.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

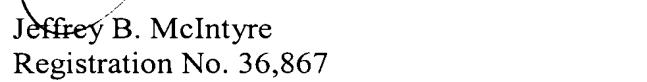
Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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